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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,748	09/24/2001	Tetsuya Katagiri	48864-042	5033

7590 02/02/2006  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/960,748

Applicant(s)

KATAGIRI ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 9, 20-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 30, 2005 has been entered.

### ***Telephone Interview***

2. In a telephone conversation on January 30, 2006, Edward Wise (Registration No. 34,523) was informed that the case was in condition for allowance except for three minor issues. Mr. Wise was informed that first, it appears that claim 29 consists of the limitations of claim 9 rewritten as a new independent claim including all the limitations of base claim 1. However, this appears to be a mistake because the applicants indicated (page 13) that claim 29 consists of the limitations of claim 7 rewritten as a new independent claim including all the limitations of base claim 1. Note that current claims 1 and claims 29 are duplicate claims. The Examiner suggested that the last two lines of claim 29 be replaced with the limitation of claim 7 in an Examiner's amendment, but Mr. Wise declined the suggestion.

Next, assuming that claim 29 was intended to recite the limitations of original claims 1 and 7, the Examiner pointed out that claims 7 and 9 would result in duplicate claims. For instance, claim 7 depends from claim 1, which was amended to include the limitations of claim

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9. Thus, claim 7 consists of the limitations of original claims 1, 7, and 9. Claim 9 depends from claim 29, which is assumed to include the limitations of original claims 1 and 7. Thus, claim 9 would also consist of the limitations of original claims 1, 7, and 9. Consequently, claims 7 and 9 are considered to be duplicate claims if claim 29 is to be amended to include the limitations of original claims 1 and 7. Again, the Examiner suggested that either claims 7 or 9 be canceled in an Examiner's amendment, but Mr. Wise declined the suggestion.

Finally, claims 20 and 32 recite the step of "measuring a relative posture" in line 6. Mr. Wise was informed that the phrase should read, "measuring a relative position and relative posture" in order to maintain consistency throughout the claim language. Mr. Wise requested that the objections to the claims be made in writing. In response to his request, the following objections are made.

### *Claim Objections*

3. Claim 29 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

As noted above, claims 1 and 29 are duplicate claims. It appears that claim 29 was intended to include the limitations of original claims 1 and 7 instead of original claims 1 and 9. Thus, the Examiner suggests replacing the last two lines of claim 29 with the limitation of claim 7.

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Claims dependent from claim 29 are also objected to due to their dependency.

NOTE: In the event that claim 29 is amended to include the features of original claims 1 and 7 as suggested, the Examiner would like to point out that claims 7 and 9 would be duplicate claims. In that case, either claims 7 or 9 should be canceled.

4. Claims 20 and 32 are objected to because the phrase “the measured relative positions and the relative postures measured at each of the measurements” in lines 9-10 lacks antecedent basis. The Examiner suggests amending the phrase “measuring a relative posture” in line 6 to read “measuring a relative position and relative posture.” Appropriate correction is required.

Claims dependent from claims 20 and 32 are also objected to due to their dependency.

#### ***Allowable Subject Matter***

5. Claims 1-8 are allowed.


#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 571-272-7421. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ck

January 30, 2006

